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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
08/950,902	10/15/97	HAGIWARA	S-2418

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EXAMINER

SHERRER, C

ART UNIT

PAPER NUMBER

1761

DATE MAILED: 01/08/99

Please find below and/or attached an Office communication concerning this application or
proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.
08/950,902

Applicant(s)
Hagiwara

Examiner
Curtis E. Sherrer

Group Art Unit
1761



☒ Responsive to communication(s) filed on Oct 15, 1997

☐ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 3 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claims

☒ Claim(s) 1-8 is/are pending in the application.

Of the above, claim(s) _____ is/are withdrawn from consideration.

☐ Claim(s) _____ is/are allowed.

☒ Claim(s) 1-8 is/are rejected.

☐ Claim(s) _____ is/are objected to.

☐ Claims _____ are subject to restriction or election requirement.

Application Papers

☒ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on _____ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

☒ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☒ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been
☒ received.

☐ received in Application No. (Series Code/Serial Number) _____.

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

☒ Notice of References Cited, PTO-892

☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). _____

☐ Interview Summary, PTO-413

☒ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

Part III DETAILED ACTION

Priority

1. Receipt is acknowledged of papers submitted under 35 U.S.C. 119(a)-(d), which papers have been placed of record in the file.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

3. Claim 6 is rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The specification discloses that the nutrient solution is sterilized before any yeast is added and said sterilization would denature any enzymes that were previously added. Therefore, the nutrient solution to which the yeast is added contains no hydrolase.

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

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5. Claims 2 and 5 to 7 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

6. Claim 2 is considered indefinite because it is unclear how the phrase "or a ground product thereof" embodies a limitation different from "grounds left after coffee extract is prepared."

7. Claim 5 is considered indefinite because the scope of the phrase "nutrients necessary for the growth of the yeast." Specifically, it is not known what is "necessary," as those nutrients that are vital for the yeasts' growth change depending on their environment.

8. Claim 4 is considered indefinite because there are no units associated with the claimed range.

9. Claim 7 is considered to be indefinite because it is unclear if the phrase "(*Saccharomyces cerevisiae*)" is meant to be a limitation.

Claim Rejections - 35 USC § 102

10. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

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11. Claim 8 is rejected under 35 U.S.C. 102(b) as being anticipated by Papazian (The New Complete Joy of Home Brewing, pp. 95-99).

12. Papazian teaches the well known addition of coffee to beers (pages 98 to 99). Because the claims broadly includes all extract obtained from coffee it is considered that the beers taught by Papazian inherently possess the extract as claimed. The Office does not have the facilities for examining and comparing Applicant's product with the product of the prior art in order to establish that the product of the prior art does not possess the same material structural and functional characteristics of the claimed product. In the absence of evidence to the contrary, the burden is upon the applicant to prove that the claimed are functionally different than those taught by the prior art and to establish patentable differences. See *In re Best*, 562 F.2d 1252, 195 U.S.P.Q. 430 (CCPA 1977); *Ex parte Gray*, 10 U.S.P.Q.2d 1922, 1923 (BPAI).

Claim Rejections - 35 USC § 103

13. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

14. Claims 1 to 5, 7 and 8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Adams et al. (Tropical Science Vol. 23, No. 2, pp. 177-96) or Papazian.

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15. Adams *et al.* (Adams) teach the use of “coffee pulp” to produce wine (page 191). The article states that “substantial quantities of sugar [are added] to the juice. The coffee pulp appears to be the residue from the initial steps performed in processing the raw coffee bean, i.e., before the coffee is roasted and extracted. Therefore, Adams et al teach the usefulness of recycling coffee processing wastes to produce alcohol coffee drinks from the initial stages of coffee production but not from the latter.

16. Papazian teaches that it is well known to add a wide variety of flavoring materials to beer including cinnamon, licorice, ginger, horseradish, garlic, chicken and coffee. While Papazian, nor Adams, teach the specific use of coffee grounds, it would have been obvious to those of ordinary skill in the art to produce alcoholic coffee drinks from any or all parts of the coffee process including the grounds because alcoholic beverage producers have traditionally added a wide variety of flavors to produce drinks with novel flavors and tastes.

17. In addition, Applicants’ attention is invited to *In re Levin*, 84 USPQ 232 and the cases cited therein, which are considered in point in the fact situation of the instant case, and wherein the Court stated on page 234 as follows:

This court has taken the position that new recipes or formulas for cooking food which involve the addition or elimination of common ingredients, or for treating them in ways which differ from the former practice, do not amount to invention, merely because it is not disclosed that, in the constantly developing art of preparing food, no one else ever did the particular thing upon which the applicant asserts his right to a patent. In all such cases, there is nothing patentable unless the applicant by a proper showing further establishes a coaction or cooperative relationship between the selected ingredients which produces a new,

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unexpected, and useful function. *In re Benjamin D. White*, 17 C.C.P.A (Patents) 956, 39 F.2d 974, 5 USPQ 267; *In re Mason et al.*, 33 C.C.P.A. (Patents) 1144, 156 F.2d 189, 70 USPQ 221.

18. Claim 6 is rejected under 35 U.S.C. 103(a) as being unpatentable over Adams et al. (Tropical Science Vol. 23, No. 2, pp. 177-96) or Papazian in view of Suzuki (U.S. Pat. No. 3,845,220).

19. Adams and Papazian teach that cited above but do not disclose the addition of a hydrolase. Suzuki teaches the addition of an enzyme, such as a protease, amylase, cellulase, hemicellulase and pectinase to modify the foaming properties of a coffee carbonated beverage. It would have been obvious to those of ordinary skill in the art to add a hydrolase as done by Suzuki to the alcoholic beverages of Adams or Papazian because it is beneficial to the foaming properties of the beverages.

Conclusion

20. No claim is allowed.

21. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Curtis Sherrer whose telephone number is (703) 308-3847. The examiner can normally be reached on Tuesday through Friday from 6:30 to 4:30.

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22. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Lacey, can be reached on (703)-308-3535. The **fax phone number** for this Group is (703)-305-3602.

23. Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 308-0661.

A handwritten signature in dark ink, appearing to read "Curtis E. Sherrer". The signature is fluid and cursive, with a long horizontal stroke extending to the right.

Curtis E. Sherrer

January 5, 1999